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09/639,908	08/16/2000	Raymond Anthony Joao	RJ251	3583

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EXAMINER

BERGIN, JAMES S

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 05/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/639,908

Applicant(s)

JOAO, RAYMOND ANTHONY

Examiner

James S. Bergin

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 42,61-91 and 93-100 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 42,61-91 and 93-100 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☒ Interview Summary (PTO-413) Paper No(s). 19.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. In response to the telephone interview of 3/10/2003 with Raymond Joao, the election of species requirement of 2/11/2003 has been withdrawn at this time as a courtesy to Mr. Joao, the attorney/ applicant. Depending on the future prosecution history in this case and any future amendments to the claims, the examiner may require a new restriction or election of species at that time, should more than one invention or more than one patentably distinct species be identified in the case which places an overly burdensome search requirement as determined by the examiner.

Specification

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

3. The numbering of claims is not in accordance with 37 CFR 1.126. New claims must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not). Currently, as there is no claim 92 in the case, claims 93-100 are numbered improperly.

Claim Rejections - 35 USC § 112

Art Unit: 3624

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5. Claims 42, 61-91 and 93-100 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 42, 68, 73, 83 and 95, the occurrence of "and/or" renders the claim indefinite.

In claim 68, the phrase, "wherein the transmitter transmits the report to at least one of the first communication device and a second communication device" is indefinite because it is unclear if an attempt is being made to positively claim a first communication device in addition to a second communication device. A first communication device is at least one of a first communication device and a second communication device.

In claim 81, "wherein the apparatus is utilized at least one of on and over at least one of the Internet and the World Wide Web" is unclear.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 42, 61-81, 83-91, and 93-100 are rejected under 35 U.S.C. 102(e) as being anticipated by Ray et al. (US 6,018,722 A).

Regarding independent claim 42, Ray et al. disclose an apparatus for providing financial information and investment information to an investor comprising a receiver (col. 3, lines 4 – 35; and figure 2, the receiver being a component of the base station grouping and CPU 245 and hub 215); wherein the receiver receives a request to receive information regarding a change in at least one economic, fundamental technical or risk/return factor and information regarding a correlation of the least one factor with at least one of a variety of different types of securities. All of the factors mentioned in Ray et al. are correlated to the performance of securities (col. 2, lines 20 – 40). Ray et al. further disclose a processor (see figure 2, a component of base station grouping and CPU 245 and hub computer 215) detecting the change in the factor, processing the request and generating at least one of a signal, a message, and a report for transmission by transmitter (figure 2, component of base station grouping) to the communication device 210 of the investor (col. 3, lines 4 – 35).

Regarding independent claim 68, refer to the section above concerning claim 42. Additionally, Ray et al. disclose a database (a component of base station grouping and CPU 245 and hub computer 215) for storing the data about the correlated factor for at least some increment of time (col. 10, lines 55 – 65). Ray et al. disclose first communication device 210. It is the opinion of the examiner that the second communication device of applicant's claim 68 has not been positively claimed by the current claim language.

Regarding independent claim 73, refer to the section above concerning claim 42.

Regarding independent claim 83, refer to the section above concerning claim 42. Additionally, Ray et al. disclose that the processor of the expert system can perform a transaction on he part of the investor (col. 9, lines 28 – 43).

Regarding independent claim 95, refer to the section above concerning claim 42. The communication device 210 is a display device.

Regarding claims 61, 62, see the section on claim 42 above.

Regarding claim 63, see the section on claim 68 above.

Regarding claim 64, Ray et al. disclose the online computer services 230 (fig. 2).

Regarding claim 65, Ray et al. disclose research and investment recommendations (col. 3, lines 12-35 and col. 9, lines 29 – 43).

Regarding claim 66, Ray et al. disclose electronic transmission or fax modem transmission of the signal, message or report (col. 3, lines 4 –11).

Regarding claim 67, when the investor views the research and investment recommendations of the Ray et al. apparatus, they are being notified of a value for the

factor. The investor will see how this factor has changed or has not changed since last viewed. So the Ray et al. apparatus notifies the investor of whether the factor has changed provided the investor views the recommendations on at least two separate occasions.

Regarding claim 69, see the section above on claim 64.

Regarding claim 70, Ray et al. disclose research and investment recommendations (col. 3, lines 12-35 and col. 9, lines 29 – 43).

Regarding claim 71, see the section above on claim 66.

Regarding claim 72, see the section above on claim 67.

Regarding claim 74, see the section above on claim 42.

Regarding claim 75, Ray et al. disclose the communication device 210.

Regarding claim 76, see the section above on claim 68.

Regarding claim 77, Ray et al. disclose the online computer services 230 (fig. 2).

Regarding claim 78, Ray et al. disclose research and investment recommendations (col. 3, lines 12-35 and col. 9, lines 29 – 43).

Regarding claim 79, Ray et al. disclose electronic transmission or fax modem transmission of the signal, message or report (col. 3, lines 4 –11).

Regarding claim 80, see the section above on claim 67.

Regarding claim 81, Ray et al. disclose online computer services 230.

Regarding claim 84, see the section above on claim 61.

Regarding claim 85, see the section above on claim 75.

Regarding claim 86, Ray et al. disclose a database (a component of base station grouping and CPU 245 and hub computer 215) for storing the data about the correlated factor for at least some increment of time (col. 10, lines 55 – 65).

Regarding claim 87, Ray et al. disclose online computer services 230.

Regarding claims 88, 89, 90, 93, 96, 97, 98, 99, the limitations therein have been discussed above.

Regarding claim 91 and 100, Ray et al. discloses that the advisor expert system can execute the recommended transactions on behalf of the investor. Legally binding authorizations for such transactions, while not specifically mentioned, are inherent in the Ray et al. disclosure (col. 9, lines 9 – 43). To suggest that they are not would simply be preposterous.

Regarding claim 94, Ray et al. discloses the generation of order confirmations and the updating of account assets (col. 9, lines 22 – 28).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 82 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ray et al. (US 6,018,722 A).

Ray et al. does not specifically disclose that the report of advisor expert system contain information regarding at least one of a patent grant and insider trading activity. However patent grant and insider trading activity are well known events that are researched in the fundamental analysis of any equity and the examiner takes official notice of this fact. It would have been obvious, in view of this official notice, to one of ordinary skill in the art of fundamental analysis, to provide patent grant and/ or insider trading activity information in the Ray et al. research reports displayed to the investor, so as to enable the investor to be aware of these factors that could potentially impact the valuation of the equity.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Anaya et al. (US 2003/0055768 A1) discloses an alert delivery and delivery performance in a monitoring system; Li (US 6,453,303 A1) discloses a system for automated analysis for financial assets; Nevo et al. (US 5,946,666) discloses a monitoring device for financial securities; Horowitz et al (US 6,349,290 B1) discloses a system for providing customized and personalized investment advice to a user over the internet or PDA; Jones et al. (US 6,021,397 A) discloses a financial advisory system wherein alerts can be transmitted during a user session or transmitted to the user over a pager, fax or similar messaging system; Davis et al. (US 6,378,073 B1) discloses a portable financial messaging unit; and Flood (GB 2,219,423 A) discloses a page for receiving financial or trading market information.

Art Unit: 3624

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James S. Bergin whose telephone number is 703 308-8549. The examiner can normally be reached on Monday-Thursday 8.30-6.00 and on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703 308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are 703 305-7687 for regular communications and 703 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-1113.



JSB
May 3, 2003



HANI M. KAZIMI
PRIMARY EXAMINER